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30 Rockefeller Plaza
New York, NY 10112-4498

In re Application of	:	
VAN SAARLOOS, Paul, Phillip, et al.	:	
U.S. Application No. 09/762,824	:	DECISION ON PETITION
PCT No.: PCT/AU99/00665	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 16 August 1999	:	AND 37 CFR 1.47(b)
Priority Date: 14 August 1998	:	
Attorney Dkt. No. A3418-PCT/USA-062635.0133	:	
For: SURGICAL VISUAL FEEDBACK AND	:	
EYE FIXATION METHOD AND	:	
APPARATUS	:	

This is a decision on applicant's "Petition Under 37 CFR 1.137(b) For Revival Of Unintentionally Abandoned Application" and the "Petition Under 37 CFR 1.47(b)" to accept the application without the signatures of joint inventors Paul Phillip Van Saarloos and Jon Dishler filed 26 December 2001. Applicant has paid the required petition fees.

BACKGROUND

On 16 August 1999, applicant filed international application PCT/AU99/00665 which claimed a priority date of 14 August 1998 and which designated the United States. On 24 February 2000, a copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) by the International Bureau (IB).

A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, i.e., 14 February 2001.

On 14 February 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied by, among other materials, payment of the basic national fee.

On 14 March 2001, the United States Designated/Elected Office mailed a Notification Of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the \$130 surcharge for filing the declaration later than thirty months after the priority date were required. The notification set a one-month time limit in which to respond.

On 26 December 2001, applicants filed the "Petition Under 37 CFR 1.137(b) For Revival Of Unintentionally Abandoned Application" and the "Petition Under 37 CFR 1.47(b)" to accept

the application without the signatures of joint inventors Paul Phillip Van Saarloos and Jon Dishler considered herein.

DISCUSSION

A. Petition Under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the “entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional,” and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Items (2), (3), and (4) have been satisfied.

Regarding item (1) above, the petition under 37 CFR 1.47(b) is not grantable in its present form, as indicated below. Thus, all of the requirements of 37 CFR 1.137(b) for a complete response have not been fulfilled. The petition to revive is therefore **DISMISSED** without prejudice.

B. Petition under 37 CFR 1.47(b)

In order to comply with the proper response requirement of item (1) above for revival under 37 CFR 1.137(b), applicant submitted a petition under 37 CFR 1.47(b). In order for the item (1) proper response requirement to be satisfied, under the present circumstances, the petition under 37 CFR 1.47(b) must be grantable. A grantable petition under 37 CFR 1.47(b) must include: (1) the requisite petition fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present submission satisfies items (1), (2), (3), (4) and (6). However, as discussed below, item (5) has not been satisfied.

Item (5) is discussed in section 409.03(f) of the MPEP, which states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

The basis of the 37 CFR 1.47(b) applicant's claim of proprietary interest is the "Statement Of Facts Establishing Proprietary Interest By Person Signing On Behalf Of Nonsigning Inventor" and attachments thereto. One of the attachments to this Statement is an assignment in which non-signing co-inventor Jon Dishler expressly assigns to The Lions Eye Institute Of Western Australia ("LEI") his interest in the international application being nationalized here. A separate attachment to the Statement is an assignment from LEI to Q-Vis Limited, the 37 CFR 1.48(b) applicant, of LEI's interest in the same international application. Thus, the submission provides a showing of the chain of title to the 37 CFR 1.47(b) applicant from co-inventor Dishler. With respect to co-inventor Van Saarloos, employment agreements between Dr. Van Saarloos and LEI have been provided as evidence of the 37 CFR 1.47(b) applicant's proprietary interest. However, both of these employment agreements contain some restrictions on the employers' right to intellectual property developed by Dr. Van Saarloos (i.e., intellectual property developed "within the existing or contemplated scope of any portion of the Institute's business;" or "within the scope of his employment"). The 37 CFR 1.47(b) applicant here has not provided evidence that the inventions underlying the present application fall within the scope of these employment agreements. Accordingly, the 37 CFR 1.47(b) applicant must provide further evidence to support its claim of proprietary interest with respect to Dr. Van Saarloos. Such evidence should include statements from any persons with first hand knowledge that the invention underlying the present application was made by the inventor during the period of his employment and within the course of the inventor's duties, and a legal memorandum to the effect that a court of competent jurisdiction would by the weight of authority in the appropriate jurisdiction award title in the invention to the 37 CFR 1.47(b) applicant. Until such further evidence is provided, item (5) of a grantable petition under 37 CFR 1.47(b) has not been satisfied.

Based on the above, petitioner has not satisfied all the requirements for a grantable petition under 37 CFR 1.47(b). Accordingly, it is inappropriate, on the present record, to accord the national stage application status under 37 CFR 1.47(b).

CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

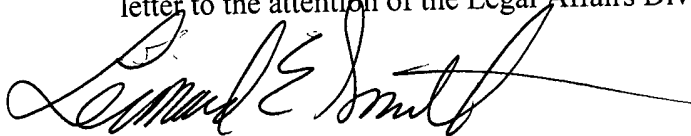
The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED** with regards to national stage processing in the United States.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

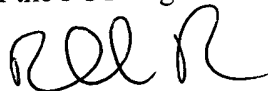
A proper response must include an acceptable petition under 37 CFR 1.47, or an oath/declaration signed by all of the named inventors in compliance with 37 CFR 1.497.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Legal Affairs Division of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office

RMR/LS:rmr



Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459